

REMARKS

In this preliminary amendment, applicant has amended claims 1, 2, 10, 11 and 12, and added claim 13. No claims have been canceled. Thus, claims 1-6 and 9-13 remain pending.

Interview

Applicant thanks the Examiner for the interview conducted on May 19, 2008 in which proposed amendments to the claims were discussed and for which the Examiner provided an Interview Summary dated May 22, 2008.

Claims Rejected Under Section 102

In the final rejection of the parent case dated March 19, 2008, the Examiner rejected claims 1-2, 5-8, 10 and 12 under 35 U.S.C. § 102(b) as allegedly being anticipated by Lui'344 (US Patent No. 6021344). See the Office Action for the specific rejections.

Initially, applicant points out that Lui'344 teaches in order to view potential disease sites, endogenous fluorophores such as tryptophan, collagen cross-links, collagen, elastin, NADH and others in the illuminated skin tissue are excited by the photons of the excitation light and emit fluorescence light (see Col. 3, lines 1-5). The present invention uses chemiluminescent light, which is a weak light source and does not cause the components of the skin to "emit fluorescence light," but only provides reflected light.

To anticipate a claim under 35 U.S.C. § 102(b), the reference must teach each and every element of the claim. "A claim is anticipated only if each and every element as set forth

in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631 (Fed. Cir. 1987).

Applicants respectfully submit that Lui'344 does not teach each and every element of Claim 1. Claim 1 has been amended to recite performing the claimed method using a "chemiluminescent light source" "in an examination room... wherein the normal level is the level at which the examination room is typically illuminated when an examination is not being performed, [and] without reducing the ambient light from the normal level"

First of all, Lui'344 does not teach a chemiluminescent light source. Furthermore, Lui'344 teaches away from performing the diagnostic method taught therein under normal ambient light conditions. For example, Lui'344 states "Referring to FIG. 1, there is shown a schematic block diagram of a preferred embodiment of the apparatus of the present invention useful for dark room diagnosis of a skin disease site." (Col. 2, lines 50-53). Lui'344 also states "The foregoing apparatus is best operated under low ambient light conditions so as to minimize interference with the relatively weak fluorescence signals." (Col. 2, lines 61-64). Lui'344 also states "In a further aspect, the present invention provides a method of diagnosing a skin disease site in low ambient light environment" (Col. 2, lines 21-23).

Accordingly, in Lui'344, the lights in the diagnostic room would either be turned off or at least significantly dimmed. The advantage of the present invention is being able to perform the claimed method in a room with the lights at a normal level. In other words, the method is performed without having to dim the lights.

The Examiner points out that the method taught in Lui'344 can be performed in "normal ambient lighting conditions," citing Col. 5, lines 51-55. However, this is only done when

using the "intensified viewing apparatus" shown in FIG. 3 (otherwise, Lui'344 teaches that the ambient light has to be dimmed or off, as discussed above). As discussed at Col. 5, lines 17-43, the intensified viewing apparatus consists of a number of different filters and lenses and allows viewing of specific fluorescence images. As mentioned above, the claimed chemiluminescent light source is a weak light source that only provides reflected light and not fluorescence light. Therefore, the intensified viewing apparatus of Lui'344 would not work with a chemiluminescent light source.

Claim 2 has been similarly amended. Accordingly, it is believed that claims 1 and 2 and all claims dependent thereon are in condition for allowance.

Claim 10, further distinguishes over Lui'344 because it recites "wherein the spectacles are worn by an examiner, and wherein the reflected light is only filtered by a single lens on its path to the examiner's eye." The intensified viewing apparatus of Lui'344, which is shown in FIG. 3 is not intended to be worn by an examiner, but is instead a binocular device with a plurality of filters and lenses through which light must pass. In the claimed method an examiner simply dons a pair of spectacles and the light only has to pass through a single lens to each eye (or to a single eye). This clearly distinguishes over Lui'344.

Claims Rejected Under Section 103

The Examiner has rejected Claims 3-4 and 8-9 as under 35 U.S.C. § 103(a) as allegedly being unpatentable over Lonky'983 (US Patent No. 5,329,938). See the Office Action for the specific rejections.

Lonky does not teach or suggest performing his diagnostic method with the lights at a normal level either. In fact, Zila Pharmaceuticals, Inc., the owner of the present application is also the owner of the Lonky patent. In performing

the diagnostic method taught in the Lonky patent, the lights are turned off or significantly dimmed. The advantage of the presently claimed method is being able to perform the method with the normal room lights on.

Claims 3-4 and 9 depend from claim 2 (claim 8 has been canceled) and therefore patentably distinguish over Lui'344 as discussed above. Accordingly, applicants respectfully request the withdrawal of the § 103 rejection.

In summary, Lui'344 does not teach using a chemiluminescent light source and Lonky does requires dimming the lights to perform the examination. Lui'344 teaches performing an examination with the ambient light on, but this is only when using the intensified viewing apparatus, which allows the viewing of fluorescence light, which a chemiluminescent light source does not provide. Therefore, performing the method taught in Lui'344 using the chemiluminescent light source of Lonky and the intensified viewing apparatus of Lui'344 would not work. Therefore, the presently claimed invention is novel and unobvious.

It is believed that all claims now pending patentably define the subject invention over the prior art of record and are in condition for allowance and such action is earnestly solicited at the earliest possible date.

Request for Telephone Conference

If, after considering this Amendment, the Examiner believes that any of the pending claims are not properly allowable, Applicants request that the Examiner please contact their authorized representative identified below by phone prior to issuing any further Office action for the purpose of hopefully resolving any such issue.

Please charge our Deposit Account No. 10-0440 if any additional fees are necessary for this matter.

Respectfully submitted,

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Dated: 6/19/08

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